

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 13470US02)

In the Application of:

Henry Samueli et al.

U.S. Serial No.: 09/620,919

Filed: July 21, 2000

For: ETHERNET SYSTEM

Examiner: Chi Ho A. Lee

Group Art Unit: 2416

Conf. No.: 4027

Customer No.: 23446

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via EFS-Web to the United States Patent and Trademark Office on February 13, 2009.

/Michael T. Cruz/
Michael T. Cruz
Reg. No. 44,636

RESPONSE AT REQUEST OF EXAMINER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is a response at the request of Examiner Lee of the United States Patent and Trademark Office during a telephone conference with Applicants' representative, Michael T. Cruz, Reg. No. 44,636, on February 13, 2009.

Remarks begin on page 2.

U.S. Application No. 09/620,919, filed July 21, 2000
Attorney Docket No. 13470US02
Response dated February 13, 2009
In Response to Request by Examiner in Telephone Conference of February 13, 2009

REMARKS

In a telephone conference on February 13, 2009 with Examiner Lee, Applicants' representative, Michael T. Cruz, Reg. No. 44,636, reiterated the concern that the Examiner should be treating the present application as a "continuation of a reissue application" and not as a "continuation reissue application".

It is respectfully submitted that the present application is not a reissue application.

It is respectfully submitted that the present application is not a "continuation reissue application".

It is respectfully submitted that the present application is merely an ordinary continuation application, the parent of which just happens to be a reissue application.

Therefore, it is respectfully submitted that all requests under reissue proceedings (e.g., requests for supplemental declaration) are not necessary and should be withdrawn.

Applicants respectfully direct the attention of the Examiner to M.P.E.P. § 1451.

M.P.E.P. § 1451 makes a distinction between (1) a "continuation of a reissue application" which is treated as an ordinary continuation application and (2) a "continuation reissue application" which is treated as a reissue application.

The present application is a "continuation of a reissue application" which should be treated as an ordinary continuation application under ordinary proceedings before the U.S. Patent and Trademark Office (USPTO).

The present application should not be treated under reissue proceedings before the USPTO.

It is respectfully submitted that M.P.E.P. § 1451 sets a higher standard if an applicant wants an application to be treated as a "continuation reissue application".

"[T]he mere fact that the application purports to be a continuation ... of a parent reissue application does not make it a reissue application itself, since it is possible to file a 35 U.S.C. 111(a) continuing application of a reissue application." M.P.E.P. § 1451.

U.S. Application No. 09/620,919, filed July 21, 2000

Attorney Docket No. 13470US02

Response dated February 13, 2009

In Response to Request by Examiner in Telephone Conference of February 13, 2009

“There must be an identification, *on filing*, that the application is a continuation reissue application, as opposed to a continuation of a reissue application”. M.P.E.P. § 1451 (emphasis added).

“Thus, the specification must be amended to state that the application is a ‘continuation reissue application’ of its parent reissue application.” M.P.E.P. § 1451.

The present application does not state that it is a “continuation reissue application” as set forth in M.P.E.P. § 1451.

Instead, the present application states that it is a continuation of a reissue application.

The attention of the Examiner is respectfully directed to the Preliminary Amendment filed July 21, 2000 which states that “[t]his application is a continuation of allowed Application No. 09/252,551 filed February 18, 1999, which was a reissue of Patent No. 5,604,741 issued February 18, 1997”. Preliminary Amendment filed July 21, 2000 at page 1.

Thus, it is respectfully submitted that the present application is a “continuation of a reissue application”. It is not a “continuation reissue application” as set forth in M.P.E.P. § 1451.

It was noted by the Examiner that a parent reissue declaration of the parent reissue application was filed in the present application; and therefore, the present application should be considered a “continuation reissue application”.

However, the fact that the parent reissue declaration of the parent reissue application was filed in the present application is not relevant to a determination as to whether the present application is a “continuation reissue application” or a “continuation of a reissue application”.

The present application is a continuation of a parent application that happens to be a reissue application. Thus, in filing the present application, Applicants merely submitted the declaration of the parent application, which is standard procedure before the USPTO. The declaration of the parent application just happens to be a reissue declaration.

The fact that the parent application happens to be a reissue application and the fact that

U.S. Application No. 09/620,919, filed July 21, 2000

Attorney Docket No. 13470US02

Response dated February 13, 2009

In Response to Request by Examiner in Telephone Conference of February 13, 2009

the declaration of the parent application happens to be a reissue declaration have no bearing on determining whether the present application is a “continuation reissue application” or a “continuation of a reissue application” since, in either case, Applicants are merely filing the declaration of the parent application, which just happens to be a reissue declaration of a parent reissue application.

In summary, Applicants clearly stated that the present application is a continuation of a reissue application in the Preliminary Amendment filed with the present application. Applicants did not state with the filing of the present application that the present application is a “continuation reissue application” as required by M.P.E.P. § 1451. Finally, the fact that Applicants submitted the declaration of the parent application which happened to be a reissue declaration of the parent reissue application carries no weight in determining whether the present application is a “continuation of a reissue application” or a “continuation reissue application”. Applicants were merely filing the declaration of the parent application, which just happens to be a reissue declaration, as is typical of general continuation practice before the USPTO.

It is therefore respectfully requested that the Examiner treat the present application as an ordinary continuation application and withdraw any special requests based on reissue practice before the USPTO.

Applicants do not necessarily agree or disagree with the Examiner’s characterization of the documents made of record, either alone or in combination, or the Examiner’s characterization of recited claim elements. Furthermore, Applicants respectfully reserve the right to argue the characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the recited claim elements should that need arise in the future.

Applicants respectfully reserve the right to pursue, without prejudice, subject matter (e.g., claimed subject matter) that has been amended, withdrawn and/or cancelled in a continuing and/or related application.

U.S. Application No. 09/620,919, filed July 21, 2000

Attorney Docket No. 13470US02

Response dated February 13, 2009

In Response to Request by Examiner in Telephone Conference of February 13, 2009

With respect to the present application, Applicants hereby rescind any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer of claim scope, if any, and the alleged prior art that it was made to allegedly avoid, may need to be revisited. Nor should a disclaimer of claim scope, if any, in the present application be read back into any predecessor or related application.

In view of at least the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: February 13, 2009

Respectfully submitted,

/Michael T. Cruz/

Michael T. Cruz

Reg. No. 44,636

McANDREWS, HELD & MALLOY, LTD.

500 West Madison Street, Suite 3400

Chicago, Illinois 60661

Telephone: (312) 775-8000

Facsimile: (312) 775-8100